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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,819	03/31/2004	Spanky A. Raymond	1842-0010	5056
28078 7590 01/25/2007 MAGINOT, MOORE & BECK, LLP CHASE TOWER 111 MONUMENT CIRCLE SUITE 3250 INDIANAPOLIS, IN 46204			EXAMINER WOODALL, NICHOLAS W	
			ART UNIT 3733	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/25/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/813,819

Applicant(s)

RAYMOND ET AL.

Examiner

Nicholas Woodall

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-14 and 20 is/are rejected.
- 7) ☒ Claim(s) 15-19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/07/2004;11/07/2005</u> . | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, drawn to a method for sequentially inserting wafers into a space in a patient, classified in class 606, subclass 99.
  - II. Claims 7-20, drawn to an apparatus, classified in class 606, subclass 90.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the method can be performed by another materially different product such as a product that does not include a track assembly.
3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction were not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Michael Beck on January 9<sup>th</sup>, 2007 a provisional election was made without traverse to prosecute the invention of Group II, claims 7-20. Applicant in replying to this Office action must make affirmation of this

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election. Claims 1-6 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Drawings***

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference numbers 188 and 570 are not shown in the drawings.

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: reference numbers 119, 198, and 470 and reference character "h" are not shown in the specification. The examiner recommends the applicant review the specification and the drawings to make sure all reference numbers are listed in both. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheets should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be

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labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

8. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

9. The abstract of the disclosure is objected to because the abstract exceeds the word limit of 150 words. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7-13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent 6,595,998) in view of Di Giovanni (U.S. Patent 4,478,220).

Regarding claim 7, Johnson discloses a device comprising a track assembly that forms a channel from an introduction end to a discharge end and an advancement mechanism slidably disposed within the track assembly that is capable of being used on a wafer within the channel. Regarding claim 11, Johnson discloses a device further comprising an advancement gun supporting the track assembly. The advancement gun includes a manually operable trigger coupled to the advancement mechanism.

Regarding claim 11, Johnson discloses a device wherein the advancement gun includes a housing and the trigger is pivotally mounted within the housing. Regarding claim 13, Johnson discloses a device wherein the advancement gun includes a linkage couple between the trigger and the advancement mechanism to translate the pivoting of the trigger to a linear movement of the advancement mechanism. Regarding claim 20, Johnson discloses a device further comprising a cartridge that is configured to carry a plurality of wafers. The cartridge is capable of being coupled to the track assembly so the wafers can enter the track assembly through the introduction end of the track assembly. Johnson fails to disclose the device including a means for preventing retrograde movement of a wafer within the channel of the track assembly (claim 7).

Since claim 7 meets the three prong analysis for 35 U.S.C. 112 6<sup>th</sup> paragraph, which is related to means plus function, the "means for preventing retrograde movement of a

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wafer within the channel" must be construed towards the corresponding structure for providing the function as described in the specification. The examiner believes the only structure described in the specification for providing this function are the resilient prongs formed within the channel. Therefore, to meet the requirements of claim 7, the examiner must find the structure as described in the specification or any equivalents thereof. Di Giovanni teaches a device comprising a track assembly that further includes a plurality of resilient prong members formed along the upper and lower surfaces of the channel within the track assembly (claims 7-10; column 12 lines 22-68 and column 13 lines 1-42) in order to prevent backwards movement of the elements being moved through the device (column 13 lines 34-36). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Johnson with a plurality of resilient prong members formed along the upper and lower surfaces of the channel within the track assembly in view of Di Giovanni in order to prevent backwards movement of the elements being moved through the device.

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent 6,595,998) in view of Di Giovanni (U.S. Patent 4,478,220) further in view of Yoon (U.S. Patent 5,782,844).

Regarding claim 14, the combination of Johnson and Di Giovanni discloses the invention as claimed except for the advancement mechanism including a rack gear and the trigger including a clock gear arranged to cooperate with the rack gear of the advancement mechanism (claim 14). Yoon teaches a device comprising an advancement mechanism and a trigger wherein the advancement device includes a

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rack gear and the trigger includes a clock gear that cooperates with the rack gear of the advancement mechanism in order to translate the pivoting of the trigger to lateral movement of the advancement mechanism to push an inner member of the drive mechanism (column 7 lines 66-67, column 8 lines 1-68, column 9 lines 1-67, and column 10 lines 1-9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to manufacture the device of Johnson modified by Di Giovanni with the advancement mechanism including a rack gear and the trigger including a clock gear in view of Yoon in order to translate the pivoting of the trigger to lateral movement of the advancement mechanism in order to push an inner member of the drive mechanism.

***Allowable Subject Matter***

13. Claims 15-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for cited references the examiner felt were relevant to the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Woodall whose telephone number is 571-272-5204. The examiner can normally be reached on Monday to Friday 8:00 to 5:30 EST..




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NWW



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER